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Paper No. 10

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MAY 30 2003

In re Application of	:	
Aik Chong Tan et al.	:	DECISION ON PETITION
Application No. 09/736,462	:	
Filed: December 15, 2000	:	
Attorney Docket No. SC0953AM	:	

This is a decision on the petition filed January 14, 2003, requesting that the holding of abandonment in the above-identified application be withdrawn.

The petition is DENIED.

This application was held abandoned for failure to timely file a response within the meaning of 37 C.F.R. § 1.113 to the final Office action of May 9, 2002. A Notice of Abandonment was mailed on December 17, 2002.

Petitioner asserts that a response was in fact timely filed. The response was transmitted via facsimile transmission with a certificate a transmission under 37 C.F.R. § 1.8(a) dated July 8, 2002. The evidence presented satisfies the showing required under 37 C.F.R. § 1.8(b) to establish timely submission via facsimile transmission of the response. The copy of the response is hereby accepted as being timely submitted on July 8, 2002.

A review of the file record indicates that the above-identified response after final Office action was not matched with the file.

STATUTE, REGULATIONS AND PRACTICE

35 U.S.C. § 133 states that:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

37 C.F.R. § 1.113 states in part that:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicants, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

.....
(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 C.F.R. § 1.116 states in part that:

(b) After final rejection or final action (§ 1.113) amendments in an application ... may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after a final rejection... will not operate to relieve the application ... from its condition as subject to appeal or to save the application from abandonment under § 1.135...

(c) If amendments touching the merits of the application ... are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon showing of good and sufficient reasons why they are necessary and were not earlier presented.

M.P.E.P. § 714.12 states in part that:

Once a final rejection that is not premature has been entered in an application, applicant or patent owner no longer has any right to unrestricted further prosecution. This does not mean that no further amendment or argument will be considered. Any amendment that will place the application either in condition for allowance or in better form for appeal may be entered. Also amendments complying with objections or requirements as to form are to be permitted after final action in accordance with 37 C.F.R. 1.116(b).

OPINION

A reply to a final Office action must be an appeal, an amendment (or arguments) that places the application in condition for allowance or the filing of a Request for Continued Examination (RCE). The amendment and arguments submitted in the reply filed June 18, 2001 have been considered by the examiner but were not deemed to place the application in condition for allowance.

Under current after final Office action practice, it is incumbent upon an applicant to take steps to ensure against abandoning of his/her application. Because the amendment was not deemed to place the application in condition for allowance, the reply required may be a Notice of Appeal and requisite fee or the filing of a RCE. The file record reveals that petitioner did not file a Notice of Appeal or a RCE to prevent the application from becoming abandoned. While it is regrettable that the after final amendment was not promptly considered and an Advisory Action issued, the filing of a proposed after final amendment cannot save the application from becoming abandoned by operation of law.

For the above-stated reasons, the petition is denied.

That the copy of the response submitted on January 15, 2002, with the request is accepted since the USPTO apparently lost the response originally submitted.

A copy of the Advisory Action is enclosed for petitioner's file record. The date of abandonment is as indicated in the Advisory Action.

Petitioner may wish to consider filing a petition to the Director under 37 C.F.R. § 1.137(a) or (b) requesting that the application be revived.

Any request for reconsideration of this decision must be submitted within two months of the date of this decision in order to be considered timely filed.

Questions regarding this decision should be directed to Hien H. Phan, Special Program Examiner, at (703) 308-7502. Information regarding the filing a petition to revive is available in M.P.E.P. § 7111.03(c)(III) or by calling the Office of Petitions at (703) 305-9282.

The application file is being forwarded to Abandoned Files.

A handwritten signature in black ink, appearing to read 'R. Seidel', is written over a horizontal line.

Richard K. Seidel, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

enclosure: Advisory Action

Advisory ActionApplication No.
09/736,462Applicant(s)
Tan et alExaminer
Hung V. NgoArt Unit
2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jul 8, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: the added limitation to claim 1 has not previously considered

3. ☐ Applicant's reply has overcome the following rejection(s): _____
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____
- Claim(s) objected to: _____
- Claim(s) rejected: 1-3 and 6-9
- Claim(s) withdrawn from consideration: 10-27
8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

HUNG V. NGO
PRIMARY EXAMINER